

Remarks

Claims 4, 5, 22-26, 36, and 51-58 are pending in this application. Claims 38-39 and 42-50 are withdrawn from consideration as being directed to a non-elected invention. Claims 4-6, 19-37, and 40-41 are rejected. Claims 4, 5, 23-26, 40 and 41 have been amended. Claims 6, 19-21, and 27-35, 37 have been cancelled. New claims 51-58 have been added. Reconsideration and allowance of claims 4, 5, 22-26, 36, and 51-58 is requested.

Using a Translucent Matte Varnish Between a Plastic Film and A Translucent or Transparent Colored Image is not disclosed in Collier

Claim 4 has been amended to include limitations of claim 24. In addition, claim 4 has been amended to include the further limitation of applying a *translucent* matte varnish over the plastic sheet and then applying the translucent colored image on the translucent matte varnish. Support for the amendment can be found on pages 7 and 8 of the present specification.

The combination of the translucent matte varnish and the translucent colored image provides a colored image that allows a substantial amount of light through the window cover thus providing more light in through the window while also providing a more vibrant colored image. However, the combination of the translucent matte varnish and the translucent colored image also disperse the light as shown in FIG. 3 preventing objects from being discernable from the other side of the window cover. Thus, the window cover provides increased light in through a window producing a more vibrant colored image while at the same time providing privacy. The matte varnish reduces the amount of translucent ink that has to be applied to the plastic film.

None of the prior art suggests using a translucent matte varnish between a plastic film and a translucent colored image. Previously claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB2324381, and further in view of advertisement for Solar Stat, and further in view of Collier (U.S. Patent No. 4,684,675) for the reasons set forth in paragraph No. 9 of the Office Action mailed August 16, 2004.

The Examiner cited Collier as disclosing a matting lacquer to prepare a polymeric film for an artist to paint with brush strokes. The matting lacquer in Collier is not translucent as specified in claim 4. The purpose of the film in Collier is to allow an artist to place the film over a cartoon or other image in order to color comics. See column 1, lines 32-43. Thus, the

purpose of Collier is to provide a transparent (clear) file for tracing over images. This is described in more detail with respect to the rejection of claim 24.

Conversely, claim 4 specifies using a translucent matte varnish and translucent colored image on a plastic film that prevents discerning objects through the window thereby providing privacy or hiding an unwanted view. The Examiner is also directed to claim 24 where the complete argument based on Collier can be found.

Declaration under 37 CFR § 1.132 with respect to Charley

The Declaration under 37 CFR § 1.132 filed February 10, 2005, is insufficient to overcome the rejection of claims 4-6, and 19-35.

The applicant respectfully disagrees that Charley teaches printing without the use of an opaque layer for two reasons. First, Charley unambiguously discloses that print station 24d of the section cited by the Examiner in col. 2, lines 47-60 adds an opaque layer. Second, even if there were an ambiguity, one of ordinary skill in the art would interpret Charley to *require* an opaque layer because Charley discloses only mirror image printing (col. 2, lines 61-63.)

Charley unambiguously discloses that print station 24d adds an opaque layer. The Examiner alleged in a Feb. 16th, 2005 Office Action that Charley discloses printing without an opaque layer at col. 2, lines 47-60. However, the flexographical printing of lines 54-55 by the print stations 24a-24g explicitly includes an opaque layer. The printing at stations 24a-24d is described in more detail beginning on line 61 where it is indicated that an opaque layer is used at station 24d. One of ordinary skill in the art would know that the reason that Charley does not mention the opaque layer in the paragraph referenced by the Examiner because Charley is giving a high level overview of how the printing is accomplished. Once Charley gets into detail about how the printing is actually done, it is clear that the fourth print station of the previously mentioned print stations 24a-24g applies the opaque white layer (see Charley col. 3, lines 1-10.)

Furthermore, even if the section cited by the Examiner were ambiguous (which it is not), one of ordinary skill in the art would interpret the opaque layer as *required* to enable the disclosure of Charley. Both images are printed on the same side of the material. Charley uses a first image for viewing from the inside of a window, and a mirror image of the first image for viewing from the outside of a window. One of ordinary skill in the art knows that a mirror image refers to an image that is flipped over a vertical axis with reference to the first image. A mirror image is

used so that a person on the outside of the window views the same thing as a person on the inside. For example, if the letter "J" were printed on a border for viewing from both the inside of a window and the outside of the window, a normal printing of the "J" would be required followed by a mirror image printing of the "J." If a mirror image were not used, a person on the outside of the window would see a backwards "J" making the viewing illegible for the outside viewer.

With the understanding of what the mirror image printing of Charley is, it is clear why one of ordinary skill in the art would interpret the opaque layer in Charley as a requirement, and not a preferred embodiment of Charley. The opaque white layer in Charley is used to separate two colored images that are printed on the same side of the film so that a person does not see both the a first image and a mirror image of the first image at the same time. If the opaque layer were not used, the first image and the mirror image of the first image at would be printed over each other. The result would be a mess because the resulting view for anyone looking at the border would be a composite image first image and a mirror image of the first image. For example, if a "J" were printed on translucent film, followed immediately by a printing of a mirror image of a "J", the resulting image would somewhat resemble a "U" and would be illegible. Therefore, the opaque white layer in Charley is not just a preferred embodiment; it is a necessary element of his disclosure that is required for his all embodiments of his disclosure to function properly. In other words, printing without the opaque layer is not enabled in Charley.

The Examiner is directed to Exhibit A that illustrates why the opaque layer of Charley is not an optional layer. Exhibit A shows the phrase "Application 09/990,670" printed on a piece of paper. Also printed on the piece of paper directly over the phrase "Application 09/990,670" is the mirror image of the phrase. The resulting mess is what the mirror image printing of Charley would produce without the opaque layer.

Claim Rejections - 35 U.S.C. § 102

Claims 40-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by Oberwager (U.S. Patent No. 3,815,263).

Claim 40 has been amended. Support for the amendment is found in the present specification on page 8, lines 1-9 and lines 22-23. The applicant respectfully traverses the rejection. Oberwager does not anticipate claim 40 because Oberwager does not teach at least the

elements of (1) providing a single continuous piece of thin, flexible film of plastic material that (2) includes an image of a stained glass window which (3) includes multiple different colored layers of ink printed on top of each other.

Oberwager teaches a hobby kit for a person to assemble artwork. The resulting artwork is a sandwich of plastic materials, the middle of the sandwich being a multitude of plastic sheets. Oberwager requires that a user assemble all of the sheets including placing the multitude of plastic sheets correctly in between two outer sheets. The multitude of plastic sheets are single color each and do not include images. Also, the plastic sheets do not include multiple different colored layers of ink printed on top of each other. Assembling this kit is more laborious and expensive because the pieces need to be aligned. Manufacturing this kit is more expensive because of all the pieces.

In contrast, the claim includes the elements of (1) providing a single continuous piece of thin, flexible film of plastic material that (2) includes an image of a stained glass window which (3) includes multiple different colored layers of ink printed on top of each other. A single continuous piece of film is advantageous over the multitude of plastic sheets because the single piece does not require assembly time and manufacturing is less expensive. Furthermore, since no assembly is required a user does not risk misplacing the sheets and having a misaligned final product. Even further, when a multitude of sheets are stuck together there is more chance that one sheet will peel away and fall off. In contrast, the single continuous piece of film will stay adhered to a window for a much longer time. Oberwager also fails to disclose a piece of film of plastic material that includes an image. Oberwager's sheets are each uniformly colored and do not include an image or multiple colored layers. Therefore, Oberwager does not teach each and every element of claim 40.

Claim 41 is not anticipated by Oberwager for at least the same reason. Additionally, Oberwager does not disclose including a first translucent matte varnish applied between the plastic material and the translucent colored image.

Claim Rejections - 35 U.S.C. § 103

Claims 4, 32, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cliffe (U.S. Patent No. 4,528,232) in view of Taylor et al. (U.S. Patent No. 5,672,413) for the reasons set forth in paragraph No. 2 of the Office Action mailed January 27, 2004.

As previously stated by the applicant in a January 15, 2005 amendment, the combination of Cliffe and Taylor fails to teach at least the element *preventing discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image. Claims 32 and 34 have been cancelled.

Moreover, neither of Cliffe nor Taylor teach the element of applying a first translucent matte varnish.

Claims 4, 5, 19-21, 32, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. (U.S. Patent No. 6,030,002) in view of Taylor et al. and Cliffe, further in view of Rega et al. (U.S. Patent No. 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date) for the reasons of record as set forth in paragraph No. 3 of the Office Action mailed on January 27, 2004.

GB 232438 is a non-analogous reference (see MPEP 2141.01(a)) because GB 232438 is not from the field of window coverings (the field of the present invention) and because GB 232438 is not reasonably pertinent to the particular problems faced by the invention (addressing privacy and hiding an unwanted view while still allowing light to enter a window.) One of ordinary skill in the art would not refer to printing plates of GB 232438 when seeking to improve window coverings to improve privacy or hide an unwanted view.

But even if GB 232438 were analogous art, as previously stated by the applicant in a January 15, 2005 amendment, the combination fails to teach at least the element *preventing discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image. Furthermore, the combination fails to disclose applying a translucent matte varnish. Claims 19 and 21 have been cancelled.

Claims 4, 22, 32, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cliffe in view of Pohn (U.S. Patent No. 4,791,745) for the reasons of record as set forth in paragraph No. 6 of the Office Action mailed August 16, 2004.

Pohn is a non-analogous reference because Pohn is not from the field of window coverings (the field of the present invention) and because Pohn is not reasonably pertinent to the particular problems faced by the inventor (addressing privacy and hiding an unwanted view.)

Pohn is a black light display system that has nothing to do with privacy or hiding an unwanted view. One of ordinary skill in the art would not refer to Pohn when seeking to improve window coverings by improving privacy and hiding an unwanted view.

But even if Pohn were an analogous reference, the combination of Cliffe and Pohn does not teach each and every element of claim 4 for at least the reason that the combination does not teach or suggest the element *preventing discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image for the reasons previously stated by the applicant in a January 15, 2005 amendment. Furthermore, none of the references teach a translucent matte varnish. Claim 22 depends on claim 4 and should be allowed for at least the same reasons. Claims 32 and 34 have been cancelled.

Claims 4, 5, 19-22, 32, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date) for the reasons of record as set forth in paragraph No. 7 of the Office Action mailed on August 16, 2004.

The combination of Charley, Pohn, Cliffe, Rega, GB 2324381 and Solar Stat fail to teach each and every element of the invention for at least the reason that the rejection relies on Pohn and GB 2324381. Pohn and GB 2324381 are non-analogous references that should not be relied upon by the Examiner for the reasons discussed previously in this amendment. One skilled in the art would not have looked to these references when addressing deficiencies in window coverings.

But even if Pohn and GB 2324381 were analogous references, the element of *preventing discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image is neither taught nor suggested in any of the references for the reasons previously discussed with respect to each reference. Claims 5 and 22 depend on claim 4 and should be allowed for at least the same reasons. Claims 19, 21, 32 and 34 have been cancelled.

Claims 6, 23, 26, 27, 29, 31, 33 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB2324381, and further in view of advertisement for Solar Stat, and further in view of Cooledge et al. (U.S. Patent No. 5,258,214) for the reasons set forth in paragraph No. 8 of the Office Action mailed August 16, 2004.

The combination of Charley, Pohn, Cliffe, Rega, GB 2324381, Solar Stat and Cooledge fail to teach each and every element of the invention for at least the reason that the rejection relies on Pohn and GB 2324381. Pohn and GB 2324381 are non-analogous references that should not be relied upon by the Examiner for the reasons discussed previously in this amendment. One skilled in the art would not have looked to these references when addressing deficiencies in window coverings.

But even if Pohn and GB 2324381 were analogous references, the element of *preventing discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image is neither taught nor suggested in any of the references. This element is not disclosed in any of the references for the reasons previously discussed in this amendment. Additionally, this element is not disclosed in Cooledge because Cooledge allows a view (see Cooledge col. 4, lines 37-50 "may be adhered to a windshield of an automobile ... allows a driver to view the map while affording full vision of the road surface.") Cooledge does not block a view. Thus, claims 23 and 26 should be allowed. Claims 6, 27, 29, 31 33, and 35 have been cancelled.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB2324381, and further in view of advertisement for Solar Stat, and further in view of Collier (U.S. Patent No. 4,684,675) for the reasons set forth in paragraph No. 9 of the Office Action mailed August 16, 2004.

Claim 24 has been amended and is dependant on claim 4. As previously discussed, Pohn and GB 2324381 are non-analogous references. Additionally, Collier is a non-analogous reference. Collier is a non-analogous reference (see MPEP 2141.01(a)) because Collier is not from the field of window coverings (the field of the present invention) and because Collier is not reasonably pertinent to the particular problems faced by the invention (addressing privacy and hiding an unwanted view while still allowing light to enter a window.) See *In re Oetiker*, 977

F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Collier has nothing to do with windows. One of ordinary skill in the art would not refer to the cartoonist overlay of Collier when seeking to improve window coverings to improve privacy or hide an unwanted view.

But even if Collier were analogous, a *prima facie* case of obviousness has not been established at least because there is no suggestion or motivation to modify Charley with Collier and because the combination of the references does not teach each and every element of claim 24.

There is no motivation present to combine the references. As the applicant has previously stated, the applicant respectfully disagrees that Charley teaches printing without the use of an opaque layer. But even if Charley did disclose printing without the use of an opaque layer, Charley would produce faded images or would require too much ink because Charley does not apply a matte varnish before applying color images. The Examiner alleges that one of ordinary skill in the art would combine the matting lacquer of Collier to improve Charley.

However, Collier only discloses applying a matting lacquer to prepare a polymeric film for use as an overlay for an artist to *manually paint*. The purpose of the matting lacquer in Collier is to prevent streaking and other problems generated by using brush strokes associated with manual painting (see Collier col. 1, lines 15-16.) Since Charley uses automated machine printing (and not manual painting with *brush strokes*) that does not streak like manual painting, one of ordinary skill in the art would have no motivation to combine the matting lacquer layer of Collier with Charley. Imputing a motivation to combine that did not exist is using impermissible hindsight, see *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

Furthermore, in addition to the absence of a suggestion to combine, Collier would teach one of ordinary skill in the art away from applying a matte varnish to Charley. One of ordinary skill in the art, when confronted with both references, would learn from Collier that a matting lacquer should only be applied to prepare for *manual painting*. Charley uses automated machine printing and not manual painting, therefore Collier would actually discourage or dissuade one of ordinary skill in the art from even trying a matte lacquer in combination with automated machine printing because according to Collier there would be no reason to try it and it would be wasteful in machine printing.

But even if there were a suggestion to combine, combining Collier and Charley would still not produce all the elements of claim 24. None of the references disclose the translucent matte varnish element.

Collier instead teaches a *clear or transparent* matte finish and teaches away from a *translucent* matte finish. It is readily apparent that a clear finish is produced because Collier says in col. 1, lines 35-40 that he is trying to improve the ability of an artist to see through an overlay when working with or without a light table. Thus Collier teaches a clear, transparent overlay. The artist begins with a drawing including black line images. The artist then puts a clear overlay produced by Collier over the drawing and begins painting the clear overlay according to the black line images showing through the overlay. The clearer the resulting finish, the better one can see through the overlay. Furthermore, when Collier explains how to produce his invention, he instructs using transparent polystyrene film and transparent colored paint (col. 4, lines 19-37) and thus one skilled in the art would use these along with a matte lacquer that produces as *clear* a matte finish as possible. It would have been in conflict with all of the teachings of Collier to using a matte varnish to produce a translucent matte finish.

The translucent finish of the matte varnish referred to in claim 24 is what diffuses light so that the claimed window covering is able to *prevent discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image. As described in the present specification on the bottom of page 7, a clear plastic substrate is combined with transparent inks and a matte varnish that produces a *translucent* matte finish. Because the substrate and the inks are clear, it is the matte varnish the produces the desired translucency. The translucency in turn provides diffusion (see figures 1-3 of the present specification), which in turn provide the desired features of preventing discerning objects through the window thereby providing privacy or hiding an unwanted view while at the same time permitting substantially all light from either side of the window covering to pass through the window and the window covering.

If the matte lacquer of Collier were used with clear plastic and clear ink, the resulting window covering simply would not work for the purposes intended by the present applicant. The resulting window covering would be transparent and would not diffuse light (see figures 1-3 of the present specification) and thus privacy would not be achieved. Therefore, even if the matte

lacquer of Collier were combined with all of the other references, the resulting product would still be inferior to the claimed window covering because it would not prevent a view. New claims 51-55 have been added and are supported by the portions of the specification that were previously discussed.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cliffe in view of Taylor et al. (or in view of Pohn), further in view of Chmielnik (U.S. Patent No. 5,617,790) for the reasons set forth in paragraph No. 10 of the Office Action mailed August 16, 2004.

The combination of references fails to teach each and every element for reasons at least similar to claim 4. Additionally, Chmielnik is a non-analogous reference and should not be applied in this rejection. Chmielnik is an apparatus for producing printing plates and not a window covering. In addition, one skilled in the art would not turn to Chmielnik when attempting to improve window coverings by increasing privacy, hiding an unwanted view, and still allowing light through the window.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Taylor et al. (or in view of Pohn) and Cliffe, further in view of Rega et al. and GB2324381, further in view of advertisement for Solar Stat, and further in view of Chmielnik (U.S. Patent No. 5,617,790) for the reasons set forth in paragraph No. 11 of the Office Action mailed August 16, 2004.

The combination of references fails to teach each and every element for reasons at least similar to claim 4. Additionally, the combination of references does not teach each and every element of claim 25 for at least the reason that Pohn, GB 2324381, and Chmielnik are non-analogous references for the reasons previously discussed.

Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB2324381, and further in view of advertisement for Solar Stat, and further in view of Cooledge et al. and further in view of Collier for the reasons set forth in paragraph No. 12 of the Office Action mailed August 16, 2004.

Claim 28 has been cancelled.

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB2324381, and further in view of advertisement for Solar Stat, and further in view of Cooledge et al. and further in view of Collier, and further in view Chmielnik for the reasons set forth in paragraph No. 13 of the Office Action mailed August 16, 2004.

Claim 30 has been cancelled.

Claim 36 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cliffe in view of Taylor et al. or Charley et al. in view of Taylor et al. and Cliffe, further in view of Rega et al. and GB 2324381, and further in view of advertisement for Solar Stat or Cliffe in view of Pohn or Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB 2324381, and further in view of advertisement for Solar Stat and further in view of Oberwager.

The combination of references fails to teach each and every element of the invention for at least the reason that Pohn, GB 2324381, and Chmielnik are non-analogous references.

But even if Pohn, GB 2324381, and Chmielnik were all analogous references, the combination cited by the Examiner would still fail to teach the element of *preventing discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image for the reasons previously discussed.

Furthermore the combination would not include the element of the window covering simulating a stain glass effect. Oberwager describes a hobby kit that uses three plastic layers. Even if the three layers are regarded as producing a stain glass effect, the claim requires a window covering comprising thin, flexible film of plastic material, having a thickness between 4 mil and 10 mil producing the stained glass effect. Oberwager does not teach this element because Oberwager includes three layers of separate pieces of plastic.

Claim 36 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Charley et al. in view of Pohn and Cliffe, further in view of Rega et al. and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Cooledge et al., and further in view of Oberwager.

The combination of references fails to teach each and every element of the invention for at least the reason that Pohn, GB 2324381, and Chmielnik are non-analogous references.

But even if Pohn, GB 2324381, and Chmielnik were all analogous references, the combination cited by the Examiner would still fail to teach the element of *preventing discerning objects* through the window thereby providing privacy or hiding an unwanted view while at the same time *permitting substantially all light* from either side of the window covering to pass through the window, film, and the printed translucent colored image for the reasons previously discussed. Furthermore the combination would not include the element of the window covering simulating a stain glass effect for the reasons discussed above.

New claims

New claims 51-56 have been added that are supported by the present specification. In particular, support for the translucent matte finish element of these new claims is provided in the specification page 8. All of the references cited are either transparent or opaque and thus the new claims should be allowed.

New claim 57 has been added. Support for claim 57 can be found in the present specification in the last two lines on page 7.

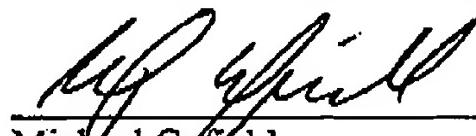
New claim 58 has been added. Support for claim 58 can be found on page 8 of the present specification.

Conclusion

The application is in condition for allowance and such action is respectfully requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Michael Cofield
Reg. No. 54,630

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613